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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,466	01/08/2002	Mario Sacchetti	US 19001	9169

7590
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EXAMINER

BROWN, JENNINE M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,466

Applicant(s)

SACCHETTI ET AL.

Examiner

Jennine M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/8/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Priority

Applicant has corrected defects in the priority of this application.

Oath/Declaration

A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date has been acknowledged.

Specification

Applicant's abstract on a separate sheet has been acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-20 are rejected under 35 U.S.C. 103(a) as being obvious over Govoni, et al. (US 6468938 B1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

See entire document. Govoni, et al. disclose applicant's prepolymerized catalyst component (US 5641721 incorporated by reference – discloses a method for preparing a prepolymerized catalyst) comprising titanium (TiCl_4 , TiCl_3 – col. 2, l. 35-39), magnesium halide (col. 2, l. 23-24), internal electron donor (col. 2, l. 40-col. 3, l. 6), halogenating hydrocarbons (col. 3, l. 19-21), wherein a BET surface area of between 20-500 m^2/g and BET porosity of 0.2-0.6 cm^3/g and porosity Hg method of 0.3-1.5 cm^3/g (col. 3, l. 66-col. 4, l. 7), aluminum alkyl compound (trialkyl aluminum,

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triisobutylaluminum, tri-n-butylaluminum, triethylaluminum, tri-n-hexylaluminum and tri-n-octylaluminum - col. 4, l. 29-40) having an Al/Ti molar ratio from 0.001 to 50 (col. 4, l. 38-40), alcohol content between 0.1-2.5 (col. 3, l. 41-56), ethylene prepolymerization up to 100 g per g of said solid catalyst component (col. 2, l. 15-19) is disclosed (col. 6, l. 57-col. 7, l. 4) the alpha olefins ($\text{CH}_2=\text{CHR}$, wherein R is hydrogen or a C1-C12 alkyl group – col. 2, l. 6-18 – e.g., propylene) are disclosed. Since the prior art appears to disclose the invention as claimed on the basis of inherent property characteristics which render the claimed product obvious, the burden of proof that it does or does not shifts to the applicant.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Govoni, et al. (US 6468938 B1) as applied to claims 1, 4-20 above, and further in view of Funabashi, et al. (US 5556820).

Govoni, et al. disclose a prepolymerized catalyst and method of making said catalyst as well as a process for the (co)polymerization of ethylene supra. Govoni, et al. fail to specifically disclose the amount of alpha olefin polymer less than 15 g per g solid catalyst component, specifically from 0.8-4 g per g of solid catalyst component. Funabashi, et al. cures the deficiency of Govoni, et al. by disclosing contacting between 1 and 500 grams of alpha olefin per 1 gram of the catalyst because it improves the catalyst to decrease micro-powder formation. The claims differ in that Funabashi, et al. does not teach the lower ranges as specific embodiments of the larger range as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Funabashi, et al. overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portions of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that; "The normal desire of scientists or artisans to improve upon what is already generally know provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", *In re Peterson* 65 USPQ 2d 1379 (CAFC 2003).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 7, 8, 14, 15, 16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2,

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4-5, 7-11, 13, 18-20 and 23 of U.S. Patent No. 6399533 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the prepolymerized catalyst component are made of the same composition, where overlapping molar ratio ranges between transition metal and aluminum occur, where overlapping ranges for the surface area and pore diameter also occur. It would have been obvious to one of ordinary skill in the art that the organic supports are identical or very similar and the catalyst composition requires titanium, aluminum and a halogen, which are described previously in the patent for olefin polymerization, therefore the claimed process and the patented process are obvious variants of one another.

Claims 1, 4, 5, 6, 9, 10, 11, 12 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6468938 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the prepolymerized catalyst component are made of the same composition, where titanium and magnesium dichloride compound are disclosed, the specific titanium compound is disclosed, the alpha olefins are disclosed, specifically propylene, and dealcoholating adducts are disclosed, therefore the claimed process and the patented process are obvious variants of one another.

Response to Arguments

Applicant's arguments with respect to Moman, et al. (US 6413901) have been fully considered and are persuasive. The previous rejection has been withdrawn.

Applicant's arguments with respect to Albizzati, et al. (US 6423660) have been fully considered and are persuasive. The previous rejection has been withdrawn.

Regarding applicant's arguments with respect to Sachetti, et al. (US 6399533), the examiner respectfully disagrees with applicant regarding the prepolymerized catalyst component. While the words may not be present in the reference, the reference to US 4,399,054 incorporated by reference therein, specifically discloses that the catalyst is prepolymerized and can be used as a support for a further catalytic reaction because the catalyst is easier to transport and less likely to deactivate in the prepolymerized state. As such, the examiner has maintained the rejection *supra*.

Regarding applicant's arguments with respect to Govoni, et al. (US 6468938), the examiner respectfully disagrees with applicant regarding applicant's assertion that the instant claims are a departure over the prior art. Govoni, et al. claim prepolymerized catalyst comprising Ti, Mg, halogen and an electron donor with ethylene up to 100 g per g of solid catalyst and does not claim that the catalyst is a stereospecific catalyst. Applicant is reading the limitations of the specification of Govoni, et al. into the limitation of the claims which is not permissible. The claims are to be given the broadest reasonable interpretation. As such, the examiner has maintained the rejection *supra*.

Examiner has added new rejections under 35 U.S.C. 103 *supra*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571)


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272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb


J.A. LORENZO
SUPERVISORY PATENT EXAMINER